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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR    | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|-------------------------|---------------------|------------------|
| 09/896,701      | 06/29/2001  | Brenda Posey Watlington | 10015140-1          | 9066             |

7590 10/15/2004  
HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

ELISCA, PIERRE E

ART UNIT PAPER NUMBER

3621

DATE MAILED: 10/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/896,701

Applicant(s)

WATLINGTON, BRENDA POSEY

Examiner

Pierre E. Elisca

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

Art Unit: 3621

### **DETAILED ACTION**

1. This Office action is in response to Applicant's Response, filed on 07/21/2004.
2. Claims 1-12 are pending.
3. The rejection to claims 1-12 under 35 U.S.C. 103 (a) as being unpatentable over AAPA and Caputo in view of Hayosh as set forth in the Office action mailed on 04/28/2004 is maintained.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-12 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Applicant's admitted prior art (AAPA) and Caputo et al. (U.S. Pat. No. 5,778,071) in view of Hayosh (U.S. Pat. No. 6,212,504).

As per claims 1-10, and 12 AAPA substantially discloses a transaction terminals that are utilized in a variety of environments, such as retail establishments, automatic teller machines, gas pump payment terminals, and the like, comprising:

Art Unit: 3621

comparing a data entry prompt for entry of data into the transaction terminal to prompts in a secure prompt table (see., fig 1, pages 2-4);

determining that the data entry prompt is a secure prompt upon the occurrence of any of the conditions of: the data entry prompt matching at least one the prompts in the secure prompt table (see., fig 1, pages 2-4, secure prompt or PIN);

transmitting the data entered into the transaction terminal in response to the data entry prompt (see., fig 1, pages 2-4);

the data entry prompt matching at least one of the prompts in the secure prompt table (see., fig 1, pages 2-4, PIN).

It is to be noted that AAPA fails to explicitly disclose that the data entry prompt matching only a portion of any of the secure prompts (portion of any of secure prompts or private/public keys), and a clear text data (text data or encryption). However, Caputo discloses a digital algorithm (algorithm or plain text data) that includes a private/public keys or portion of the secure prompts see., figs 5b, and 6, col 10, lines 51-67, col 12, lines 58-67, col 14, lines 23-51.

Accordingly, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teaching of AAPA by including the limitations detailed above as taught by Caputo because this would prevent unauthorized access to the system using encryption algorithm.

Based on the Applicant's response filed on 2/16/2004, Applicant argues that Caputo fails to disclose that the transmission of data as clear text data. The newly found prior art (Hayosh) discloses a digital signature with a clear text data (see., abstract, col 1,

Art Unit: 3621

lines 52-65, col 13, lines 30-44). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teaching of AAPA and Caputo by including the limitations detailed above as taught by Hayosh because this would produce a digital signature using clear text data (or encryption).

As per claim 11, AAPA discloses the claimed method wherein the data entry device comprises a personal identification number entry device (see., fig 1, pages 2-4).

#### RESPONSE TO ARGUMENTS

6. Applicant's arguments filed on 07/21/2004 have been fully considered but they are moot in view of new ground (s) of rejection.

#### REMARKS

7. In response to Applicant's arguments, Applicant argues that the prior art of record taken alone or in combination fail to anticipate or render obvious the recited feature:

a. " Caputo does not deal with the use of secure prompts". As indicated above, caputo discloses a digital algorithm (algorithm or plain text data) that includes a private/public keys or portion of the secure prompts see., figs 5b, and 6, col 10, lines 51-67, col 12, lines 58-67, col 14, lines 23-51. Appliacnt should note that a digital algorithm that includes a private/public keys is readable as a secure prompt.

Art Unit: 3621

b. Applicant also argues that the prior art of record fail to disclose that the transmission of data as clear text data. However, the Examiner respectfully disagrees since Hayosh discloses a digital signature with a clear text data (see., abstract, col 1, lines 52-65, col 13, lines 30-44). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teaching of AAPA and Caputo by including the limitations detailed above as taught by Hayosh because this would produce a digital signature using clear text data (or encryption).

### ***Conclusion***

**8. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 703 305-3987. The examiner can normally be reached on 6:30 to 5:00.

Art Unit: 3621

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Pierre Eddy Elisca

Primary Patent Examiner

October 12, 2004